

**REMARKS**

Claims 1-19 are pending.

Claims 1-19 are rejected.

Claims 20-28 are cancelled.

Claim 1 is amended in accordance with the Examiner in accordance with a telephonic interview conducted on August 31, 2010. During the interview, the Applicants proposed an amendment to attempt to overcome the 101 and 112 rejections. The filed amendment in the current paper is similar to the proposed amendment which the Applicants should overcome the 101/112 rejections

No new matter was added in view of these amendments.

**I. U.S.C. 101 Rejection to Claims 1-19**

The Examiner rejected Claims 1-19 under 35 U.S.C. 101. Specifically, the Examiner rejected these claims as being a method that is neither tied to a machine nor involved with a transformation of underlying subject matter. Moreover, the Examiner took issue with the term "database" as being software, merely using paper and pen, or the human mind.

On August 31, 2010, the Applicants conducted a telephonic interview with the Examiner where this rejection was discussed. The Applicants both proposed an amendment, which is how Claim 1 is currently amended, and the Applicants explained that the elements to the claim involving a user receiver, on demand programming, network connection, network, and the like are related to the management of a network which is tied to a machine and components thereon. The Examiner tentatively agreed with the Applicants' arguments but withheld their final decision until the Examiner had the chance to review such information in a written form.

Applicants note that the recent case of *Research Corp. Technologies v. Microsoft Corp.* No. 2010-1037 (Fed Cir. 2010), the Federal Circuit wrote the following:

“Indeed, the Supreme Court in *Bilski* refocused this court’s inquiry into processes on the question of whether the subject matter of the invention is abstract. The Supreme Court did not presume to provide a rigid formula or definition for abstractness. *See, e.g., Bilski*, 130 S.Ct. at 3236 (The Court has “never provide[d] a satisfying account of what constitutes an unpatentable abstract idea.” (Stevens, J., concurring)). Instead, the Supreme Court invited this court to develop “other limiting criteria that further the purposes of the Patent Act and are not inconsistent with its text.” *Id.* at 3231.

With that guidance, this court also will not presume to define “abstract” beyond the recognition that this disqualifying characteristic should exhibit itself so manifestly as to override the broad statutory categories of eligible subject matter and the statutory context that directs primary attention on the patentability criteria of the rest of the Patent Act. In that context, this court perceives nothing abstract in the subject matter of the processes claimed in the ’310 and ’228 patents. The ’310 and ’228 patents claim methods (statutory “processes”) for rendering a halftone image of a digital image by comparing, pixel by pixel, the digital image against a blue noise mask.

The invention presents functional and palpable applications in the field of computer technology. ...Indeed, this court notes that inventions with specific applications or improvements to technologies in the marketplace are not likely to be so abstract that they override the statutory language and framework of the Patent Act.”

Therefore, Applicants submit that *Research Corp. Technologies v. Microsoft Corp* affirms the principle that even if subject matter is not “tied to a machine” or “performs a transformation” (as relied to by the Examiner), such an invention can still be patentable under 35 U.S.C. 101. In present case, the claimed invention is not a mere abstract idea and involves the application of devices over a network, where such elements represent for example, an invention applied to the field of computer technology.

In summation, the Applicants assert that the pending claims are patentable over 35 U.S.C. 101 in view of the discussion that the Applicants had with the Examiner, the claimed subject matter be related to computer technologies and networks, and recent case law affirming that the present invention is patentable. Applicants request that the Examiner either (1) remove this rejection or (2) work with the Applicants in formulating claim language to overcome this rejection.

## **II. U.S.C. 112, Second Paragraph Rejection to Claims 1-19**

The Examiner rejected Claims 1-19 under 35 U.S.C. 112, Second Paragraph as being indefinite. The Examiner found, "that the recitation of the term 'Network operator' as claimed is reasonable interpreted as a limitation that is directed towards a human." In the interview with the Examiner, this issue was discussed with various proposed amendments. Claim 1, as amended, should be in a form to overcome the Examiner's reservations to the term "Network operator" where such a term is not in reference to a human being. Also, the Applicants have attempted to put prior elements of the preamble into the body of the claim as to define the network operator as the network and the network connection between a receiver and a content provider.

If the proposed amendment is still not satisfactory for the Examiner, the Applicants encourage the Examiner to propose claim language that would overcome the present rejection. In the alternative, the Applicants request that if the Examiner does not remove the rejection nor propose an amendment for the claims, that the Examiner provide an external reference that supports the Examiner's position to one of the ordinary skill in the art that a Network Operator is a person within the context of the present invention, "*the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999)*".

### **III. U.S.C. 103(a) Rejection of Claims 1-5, 7-9, and 12-19**

The Examiner rejected Claims 1-5, 7-9, and 12-19 under 35 U.S.C. 103(a) as being anticipated by Dejaeger, (U.S. Patent 6,296,185) and in further view of Payton et al. (U.S. Patent 5,790,935). Applicants disagree with this ground on rejection.

A. As amended, Claim 1 claims a "network operator" which is responsible for maintaining a network and a network connection over said network between said content provider and user receiver. The concept of a network operator in Claim 1 is

not the same what the Examiner relies in Dejaeger in view of Payton (col. 26, lines 47-66). Part of this section of the Dejaegar reference is repeated below:

“A serial port 102a of the signature capture device 102 is coupled to a fourth serial port 110c of the port expander device 110 via a serial communication line 124 (e.g., an RS-232 serial data cable). Hence, the processing unit 78b communicates with the signature capable device 102 via a data path that includes the USB communication line 102...Capturing a customer's signature with a signature capture device 102 generally causes the retailer to be charged a smaller transaction fee for the credit card transaction from the bank or other financial institution which issued the customer card.”

Clearly, a network operator as claimed in Claim 1 is not a financial institution or bank that issued a credit card or a banking institution that is like VISA or MasterCard. A network operator is claimed as controlling a network and the network is used for the connection between a content operator and a user receiver. Even if one were to argue that a network operator, as within the context of the claims/specification of the present inventor could be construed to be what is taught in Dejaeger, such a suggestion would be unreasonable and would not make sense. That is, during patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." >The Federal Circuit's *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the "broadest reasonable interpretation" standard.

In recitation to this argument, the Examiner rejected such arguments because the Examiner wrote the following:

“Applicant's argument has been considered by examiner notes that the recitation of “Network operator” as claimed is reasonable interpreted as a limitation that is directed towards a human. in amended preamble of claim 1, applicant attempts to

define network operator as a third party separate from user receiver and content provider. for this reason examiner has not given the limitation any patentable weight”.

In view of the amendments described above, the Applicants believe that the term “network operator” is not the same as a human being, whereby the Applicants’ argumentation about a Network operator in view of Dejaeger and Payton applies.

B. In the last rejection, the Examiner correctly recognized that the Dejaeger reference does not disclose or suggest the concept of a content provider nor does it recognize the concept of on-demand content which would be transmitted from such a content provider. To remedy this deficiency the Examiner combines Dejaeger with Payton as according to the Examiner, “Payton discloses a system that receives a subscribers request for on-demand content (see Payton FIG. 3b). It would have been obvious to combine the teachings of Dejaeger with those of Payton for the purpose of broadening the types of goods and services that are allowed to be purchased”.

The reasoning for supporting obviousness (why would one combine the self-service cash register of Dejaeger which lists groceries that are being purchased with an on-demand delivery system, as described in Payton?). In the most favorable light, the Examiner’s rationale is a mere conclusory statement

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396.

In response to this argument, the Examiner wrote that the Applicants are arguing that Dejaeger does not disclose “the delivery of on-demand programming”. The argument that the Applicants are making is about the rationale of combining

both Dejaeger and Payton in view of principles of law. There is no argument from the Applicants that Dejaeger does not disclose or suggest the claimed use on “on demand content”. Applicants understand that because of this deficiency in Dejaeger, the Examiner used the combination of Dejaeger and Payton. The issue the Applicants have is with the rationale of the combination.

C. Concerning the element of Claim 1 that states, “displaying summary information for each of the plurality of financial transactions upon receipt of a display request for on-demand content from a user receiver”, the Examiner writes that such an element is found in Dejaeger (in view of Payton) where the, “Examiner interprets the users operation of the checkout as a request”. It is obvious that when a user wants to checkout from a grocery system as in Dejaeger, they are paying for their groceries. This checkout of the Examiner is not “a display request for on-demand content from a user receiver”. Specifically, the request for on-demand content such as a movie or a television show is not the same as paying for your groceries as disclosed in Dejaeger with Payton.

The Examiner did not provide a response to this previously made argument in the RESPONSE TO ARGUMENTS section of the Office Action.

D. Claim 1 also refers to a “third party” and a “third party controlled database”. The Examiner claims that such a recitation is taught in col. 34, lines 44-58 of Dejaeger with Payton which refers to local memory devices that are used for a check out process. In the most favorable light, Dejaeger presumably teaches that there is some type of data that relates the UPC code that is scanned at the register and the register will indicate the price of the item via the memory device in a register. How this is the same as the “third party” and the “third party controlled database” as in Claim 1 is not clear in the Examiner’s rejection.

The Examiner did not provide a response to this previously made argument in the RESPONSE TO ARGUMENTS section of the Office Action.

E. Claim 3 claims the element of “including linking information for obtaining additional content from a specific content provider”. This specific element of Claim 3 is neither disclosed nor suggested in Dejaeger. Dejaeger does teach the concept of displaying of displaying an advertisement related to a grocery that a person is buying at a store (Dejaeger, col. 59, lines 49-64) such as when a person buys beer from a store, one would see an advertisement for beer. This disclosure of Dejaeger has nothing to do with a claimed content provider (as in Claim 3) nor does such advertisement of Dejaeger provide “linking information” to a content provider. That is, the linking information within the context of the specification (which is the broadest reasonable interpretation, see above) is used for getting on-demand content via the network provider. That is, the Examiner still does not indicate what is “linking information” nor was this discussed in the RESPONSE TO ARGUMENTS section.

## **II. U.S.C. 103(a) Rejection of Claims 6 and 11**

The Examiner rejected Claims 6 and 11 under 35 U.S.C. 103(a) as being unpatentable over Dejaeger in view of Payton.

The operation of Claim 6 is not disclosed or suggested in Dejaeger. Specifically, Dejaeger does disclose the idea of having a single format in which to display a check out transaction such as using item price, item description, and the like (see Dejaeger, col. 6, lines 48-56). This operation however has nothing to do with determining the display capabilities of a set top box which operates as the user receiver. That is, Dejaeger knows how information is going to be displayed without considering the “display capabilities” of the user receiver where the display capabilities affect which format is to be used, unlike what is claimed in Claim 6. That is, the disclosed system of Dejaeger does not perform the operation of Claim 6 nor is such an operation even suggested.

The Examiner also indicates that the claimed element of “from a plurality of

formats” corresponds to the summary information itself which could be displayed information such as the transaction information such as item price, item description, etc. This is not what display format means, as display format within the accepted parlance means for example high definition or standard definition. It does not mean the type of information that is to be displayed (as in Dejaeger).

Also, the Examiner writes that a display device and a set top box should be considered to be the same thing. They are not. From a technical standpoint, a set top box would be the device that generates a video signal and a display device displays such a video signal. In the rejection, the Examiner is essentially, stating that a receiver that generates a signal is the same as a receiver that receives a signal. Clearly, this cannot be correct. This problem is not remedied if one were to consider the complete teachings of Dejaeger with Payton.

That is, the Examiner did not respond to these previously made arguments in the RESPONSE TO ARGUMENTS section of the Office Action.

For the reasons above, Applicants request that the Examiner remove the rejection to Claims 6 and 11.

### **III. U.S.C. 103(a) Rejection of Claim 10**

The Examiner rejected Claims 10 as being anticipated by 35 U.S.C. 103(a) as being unpatentable over Dejaeger in view of Fields (U.S. Patent 4,400,724). Applicants disagree with this ground of rejection.

For the reasons given above, Applicants assert Claim 10 is patentable because such a claim depends on allowable Claim 1. Applicants request that the Examiner remove the rejection to these claims.

Respectfully submitted,



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